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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,299	07/18/2003	Arvind N. Shah	679.0044USU	7273
27623	7590	06/19/2006	EXAMINER	
OHLANDT, GREELEY, RUGGIERO & PERLE, LLP ONE LANDMARK SQUARE, 10TH FLOOR STAMFORD, CT 06901			KANTAMNENI, SHOBHA	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 06/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/622,299	SHAH ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Shobha Kantamneni	1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 April 2006.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,5-14 and 21-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) NONE is/are allowed.
- 6) Claim(s) 1, 5-14, 21-31 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                     | Paper No(s)/Mail Date: _____.   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date: _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____.                                   |

### **DETAILED ACTION**

Applicant's amendment filed on 04/03/2006, wherein claims 1, 5-7, 14 have been amended, and claims 2-4, and 15-20 have been canceled. Applicant's amendment also added new claims 21-31.

Applicant's amendment is sufficient to overcome the rejection of claims 14-19 under 35 U.S.C. 112, second paragraph, as being vague.

Applicant's amendment by canceling claim 20, is sufficient to overcome the rejection of claim 20 under 35 U.S.C. 112, second paragraph.

Applicant's amendment by limiting independent claims 1, and 14 to specific pearlescent ingredient bismuth oxychloride is sufficient to overcome the rejection of claims 1, 3-14, 16-20 under 35 U.S.C. 112, first paragraph.

Claims 1, 5-14, 21-31 are pending, and examined herein.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14, 21-31 are rejected under 35 U.S.C. 112, second paragraph, as being vague for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recitation “shade-matching a pigment component to the benchmark shade to form a shade-matched pigment component” is vague as it is not clear as to the method steps used to form a shade-matched pigment component. It is not clear as to the shade of color with which the pigment is shade matched. Is the pigment shade-matched with natural skin color or any color?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5-12, 14, 21-28, and 30-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Brieva et al. (US 5,800,816, PTO-892 of record).

Brieva et al. disclose compositions for topical application to skin comprising a pearlescent component bismuth oxychloride, and organic pigments including D&C and FD&C blues, browns, greens, oranges, reds, yellows, etc. and inorganic pigments including iron oxides, ultramarine, and chromium or chromium hydroxide colors, etc. See column 4, lines 45-55, lines 59-60; column 5, lines 14-23; column 6, lines 65-column 7, line 5. Pearlescent component, and pigments are present in an amount of 0.1 to 70 % by weight. See column 4, line 48. The composition is incorporated into a vehicle which is a color cosmetic composition such as lipstick, face powder, blush,

eyeshadow, liquid or powder, makeup. See column 4, lines 52-55. It is further disclosed that the composition can be in the form of oil emulsion makeup compositions. See column 6, lines 5-7. A method of making water in silicone emulsion make up composition comprising silicone polymer, cyclomethiocone/dimethicone copolyol; pearlescent ingredient, mica; pigments such as red iron oxide, yellow iron oxide, and water is also disclosed. It is also disclosed that the face powder or mascara composition contains dry particulate matter which is a combination of pigments with the powder comprising pearlscnt ingredient, such as bismuth oxychloride and mixtures of other ingredients such as zinc stearate, talc, mica etc. See column 4, lines 56-column 5, line ;8; column 5, lines 52—55; column 8, EXAMPLE 5. See EXAMPLE 1, column 7, lines 43-55; wherein the particulate matter comprising pigments, and pearlscnt ingredient, mice are blended, and then added to a cosmetic carrier. An eyeshadow formulation comprising Bismuth oxychloride, pigments such as black, yellow, red iron oxides is disclosed in EXAMLE 5, column 9. The composition can comprise from about 0.1-60 % of volatile components which include straight or branched chain hydrocarbons such as isododecane. See column 2, lines 44-46; EXAMPLE 2.

The recitation “pearlescent component that is matched to a natural skin tone benchmark shade” in claims 1, and 14 is inherent property of bismuth oxychloride which matches the skin’s natural pearlescence.

The recitation “a pigment component that is separately shade-matched to said benchmark shade” in claim 1 is a product-by-process limitation. Even though product-by-process claims are limited by and defined by the process, determination of

patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious over a product of the prior art the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 ('Fed. Cir. 1985). See MPEP 21 13.

Further, the recitation "shade-matching a pigment to the benchmark shade to form a shade matched pigment component" in claim 14 is inherent property of the pigment or pigment mixtures used.

Thus, Brieva et al. anticipate instant claims 1, 5-12, 14, 21-28, 30-31.

### ***Response to Arguments***

Applicant's arguments that "Brieva et al. does not teach or suggest the steps of method of claim 14..... (1) shade-matching a pearlescent component; (2) shade-matching a pigment component to the benchmark shade in a separate step; (3) blending the shade-matched pearlescent component and the shade-matched pigment component to form a shade-matched blend; and (4) adding the shade-matched blend to a cosmetic carrier to form a cosmetic composition" has been considered but not found persuasive. Brieva discloses that the shade-matched pigments are combined with powders comprising pearsclent component such as bismuth oxychloride, and further this combination is added to cosmetic carrier. See column 5, lines 52-55; column 7, EXAMPLE 1, wherein the combination of pigments and pearlscent components are added to the cosmetic carrier; see column 8, EXAMPLE 5, wherein a combination of

pearlescent component, bismuth oxychloride which inherently has a natural skin tone benchmark shade, and pigments are added to the cosmetic carrier cyclomethicone, cyclomethicone/dimethiconol.

Thus, Brieva anticipates instant claims 1, 5-12, 14, 21-28, 30-31.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 5-10, 13, 14, 21-26, 29 are rejected under 35 U.S.C. 102(e) as being anticipated by Tan et al (US 6,511,672, PTO-892 of record).

Tan et al. disclose cosmetic composition for topical application to skin comprising a platelet, bismuth oxychloride, and a pigment. It is further disclosed that the combination of platelets and pigments creates a mosaic of color and optically manipulates light such that the lines, wrinkles, disfigurations and discolorations on the skin appear to substantially vanish and the net effect is the skin appears natural, luminous and flawless. See abstract; column 4, lines 20-21; column 6, lines 15-49; column 8, claims 1,3. Inorganic pigments, and organic pigments are used in the composition. The platelet comprising bismuth oxychloride is present in an amount of 0.1

Art Unit: 1617

to 10.0 %, and the pigments are present in an amount of 0.05 to 50 % by weight. See column 4, lines 33-35; column 5, lines 12-15. It is also disclosed that the composition formed by blending pigment and bismuth oxychloride can be used in any type of skin treatment or makeup product. The makeup products include foundations, blushes, pressed or loose powders, concealers, bronzers, lipsticks, lipglosses. Also the products can be in the form of gels, sticks, water-in oil emulsions, sprays, pressed or loose powders. See column 6, lines 59-66. For liquid foundation a water-in-oil emulsion is preferred, and the oil component comprises a silicone oil. See column 7, lines 4-9; column 8, EXAMPLE 1. Tan et al. also discloses that the pigment is blended with the pearlescent to closely match the natural skin tone. See column 3, lines 56-60.

Thus, Tan et al. anticipates instant claims 1, 5-10, 13, 14, 21-26, 29.

#### ***Response to Arguments***

Applicant's arguments that "Tan et al. does not teach or suggest the steps of method of claim 14..... (1) shade-matching a pearlescent component; (2) shade-matching a pigment component to the benchmark shade in a separate step; (3) blending the shade-matched pearlescent component and the shade-matched pigment component to form a shade-matched blend; and (4) adding the shade-matched blend to a cosmetic carrier to form a cosmetic composition" has been considered but not found persuasive. Tan et al. disclose cosmetic compositions for topical application to skin comprising a 1) a pigment comprising alumina based pigment i.e alumina platelet treated with metal oxide blended with 2) a pearlescent component bismuth oxychloride which inherently has a natural skin tone benchmark shade. See column 3, line 64-

column 4, line 7; column 6, lines 50-55; column 8-10, claims 1-3, 18. Thus Tan et al. anticipates instant claims 1, 5-10, 13, 14, 21-29.

Claims 1, 5-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Simon et al (US 6,372,202, PTO-1449).

Simon discloses a colored cosmetic compositions for topical application comprising pearlescent agents, such as mica covered with bismuth oxychloride, and pigments. See column 7, lines 38-44; See column 9, EXAMPLE 2 wherein the composition comprises 8 % of bismuth oxychloride, and 5 % of pigment. The composition can be in the form of water in oil emulsion. See column 5, lines 60-63. The composition can be in the form of nail varnish, mascara, eyeliner, lipstick, lip gloss, foundation, powder etc. See column 14, claims 1, 29. A method of preparing the cosmetic composition using pearlescent component bismuth oxychloride is also disclosed. See column 9, lines 30-55.

The recitation "pearlescent component that is matched to a natural skin tone benchmark shade" in claim 1 is inherent property of bismuth oxychloride which matches the skin's natural pearlescence.

The recitation "a pigment component that is separately shade-matched to said benchmark shade" in claim 1 is a product-by-process limitation. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not

depend on its method of production. If the product in the product-by-process claim is the same as or obvious over a product of the prior art the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 ('Fed. Cir. 1985). See MPEP 21 13.

Thus, Simon et al. anticipates instant claims 1, 5-9.

### ***Conclusion***

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

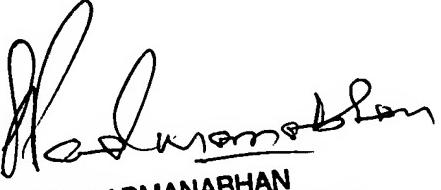
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period, will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shobha Kantamneni whose telephone number is 571-272-2930.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shobha Kantamneni  
Patent Examiner  
Art Unit 1617



SREENI PADMANABHAN  
SUPERVISORY PATENT EXAMINER